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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,213	03/31/2004	Matthew Paul Duggan	AUS920040010US1	7107
34533	7590	11/05/2008		
INTERNATIONAL CORP (BLF) c/o BIGGERS & OHANIAN, LLP P.O. BOX 1469 AUSTIN, TX 78767-1469			EXAMINER KIM, JUNG W	
			ART UNIT 2432	PAPER NUMBER
			MAIL DATE 11/05/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/815,213	Applicant(s) DUGGAN ET AL.	
	Examiner JUNG KIM	Art Unit 2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to the Appeal Brief filed on 9/8/08.
2. Claims 1-28 are pending.
3. In view of the Appeal Brief filed on 9/8/08, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Gilberto Barron Jr/
Supervisory Patent Examiner, Art Unit 2432

Response to Arguments

4. Applicant's arguments with respect to the prior art rejections have been fully considered and are persuasive. Therefore, the prior art rejections have been

withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Dunn and Bussler. See below.

5. With respect to the 101 rejections, Applicant argues that the instant claims are directed to statutory subject matter because the current law holds that a "storage medium" having stored there on are directed to statutory subject matter. (Appeal Brief, pg. 7, first full paragraph). Granted, a claim claiming a "storage medium" or "computer-readable medium" are on face value presumed to be statutory subject matter. However, this argument is insufficient because Applicant provides a definition that expands the ordinary meaning of the term to include nonstatutory subject matter; i.e. when the specification defines the medium in question as transitory in nature, the medium claimed is not statutory (In re Nuijten, No. 06-1371 (Fed. Cir. 2007), pg. 11 ["Nuijten and the PTO agree that the claims include physical but transitory forms of signal transmission such as radio broadcasts, electrical signals through a wire, and light pulses through a fiber-optic cable, so long as those transmissions convey information encoded in the manner disclosed and claimed by Nuijten. We hold that such transitory embodiments are not directed to statutory subject matter"])). Here, Applicant has claimed a product comprising a recording medium. (See claim 19) Applicant further defines that "[e]mbodiments of a computer program product may be implemented by use of any recording medium for machine-readable information, including magnetic media, optical media, **transmission media**, or other suitable media." (pg. 6, lines 20-22) As held in Nuijten, transmission media is not recognized as one of the four categories of statutory subject matter.

6. Applicant further argues that "[n]othing in the cited reference or any other language in the specification or the claims describes 'transmission media' as a signal or under any reasonable interpretation implies that Appellants are claiming a signal. ... One of ordinary skill in the art would therefore understand that 'transmission media' is a physical material." (pg. 8, 1st paragraph) Two concerns undermine Applicant's allegations. First, Applicant's specification does not appear to cabin "recording media" to statutory subject matter. Rather, the specification provides explicit evidence that a "recording media" is broadly defined by only providing exemplary evidence, including embodiments encompassing "transmission media" (pg. 6, lines 20-22). Second, Applicant's allegation is a misrepresentation of the teachings of the prior art of record. Botz US 2002/0143909, entered into the record on 3/31/04 discloses in paragraph 62: "Examples of suitable signal bearing media include: recordable type media such as CDROM (e.g., 1195 of FIG. 11) and floppy disks, and transmission type media such as digital and analog communications links." Bussler US 7,072,898, entered into the record on 10/16/07, discloses in col. 12, lines 48-51, "[t]ransmission media can also take the form of acoustic or light waves, such as those generated during radio-wave and infra-red data communications." Hence, the cited reference does in fact suggest that "transmission media" includes nonstatutory subject matter. For these reasons, Applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims do not restrict the claimed invention to statutory classes of invention. Rather, the specification defines computer program products embodied on a recording medium to encompass transmission media. (See Specification, pg. 6, line 22) Hence, these claims are not limited to statutory subject matter.

Claim Rejections - 35 USC § 103

8. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable under Dunn et al. US 7,428,750 (hereinafter Dunn) in view of Bussler et al. USPN 7,072,898 (hereinafter Bussler).

9. As per claims 19-28, Dunn discloses a computer program product for cross domain security information conversion (Abstract; col. 2:56-59), the computer program product comprising:

- a. a recording medium (3:51-4:14; 16:2-27);
- b. means, recorded on the recording medium, for receiving from a computer program product entity, in a security service, security information in a native format of a first security domain regarding a computer program product entity having an identity in at least one security domain (19:22-27; fig. 4, reference nos. 408 and 418);
- c. means, recorded on the recording medium, for transforming the security information includes means for value transformation and means for mapping a

- system entity's identity in the first security domain to another identity in the second security domain (19:29-31; fig. 2, reference no. 216);
- d. means, recorded on the recording medium, for returning to the computer program product entity the security information in the native format of the second security domain (19:32-35; fig. 4, reference no. 416);
- e. wherein means, recorded on the recording medium, for receiving security information further comprises means, recorded on the recording medium, for receiving a request for security information for the second security domain, wherein the request encapsulates the security information in a native format of a first security domain (19:20-23);
- f. wherein the computer program product entity comprises a computer program product entity requesting access to a resource in the second security domain (19:18-21; fig. 4, reference nos. 402, 412 and 416);
- g. wherein the computer program product entity comprises a computer program product entity providing access to a resource in the second security domain (19:34-37; fig. 4, reference no. 412).
10. Dunn does not disclose means, recorded on the recording medium, for translating the security information to a canonical format for security information; wherein the means, recorded on the recording medium, for transforming the security information includes means for transforming information in the canonical format using a predefined mapping from the first security domain to a second security domain; means, recorded on the recording medium, for translating the transformed security information

in the canonical format to a native format of the second security domain; wherein means, recorded on the recording medium, for transforming the security information includes means, recorded on the recording medium, for structure transformation; wherein means, recorded on the recording medium, for translating the security information in a native format of a first security domain to a canonical format comprises a procedural software function; wherein means, recorded on the recording medium, for translating the transformed security information in the canonical format to a native format of the second security domain comprises a procedural software function; and expressing the canonical format in XML, whereby security information is translated between the first native format and the second native format via the canonical format via XSL.

11. Bussler discloses an apparatus for exchanging communications between heterogeneous applications wherein data items go through five processes between a source and destination: 1) source-side native phase, 2) source-side application phase, 3) common view phase, 4) target-side application phase, and 5) target-side native phase, whereby the source-side application phase, common view phase and target-side application phase utilize XML to express the data from the source-side application to the target-side application and vice versa. (3:60-4:43; 5:15-7:51) During the source-side native phase, an item is received from a source application in its native form, wherein the syntax, encoding and arrangement is particular to the source application; this item is then converted to an application-independent syntax using "common" syntax such as an XML document. (5:15-67) During the source-side application phase, elements in the

application-independent item are rearranged to convert the item into a common view form. (6:1-34) During the common view phase, the all application-specific formatting and encoding are eliminated to generate a canonical format. (6:38-60) The target-side application phase and the target-side native phases are the corresponding reverse phases to transform and translate the canonical format item to the native format item corresponding to the target. (6:64-7:20) Furthermore, XSL is the standard means of defining transformations of an XML file. Moreover, Bussler discloses that the invention overcomes deficiencies of prior inventions, which centralize integration procedures, by disbursing the integration over the several participants of the communication. (2:30-36)

12. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made for the computer program product of Dunn to further include means, recorded on the recording medium, for translating the security information to a canonical format for security information; wherein the means, recorded on the recording medium, for transforming the security information includes means for transforming information in the canonical format using a predefined mapping from the first security domain to a second security domain; means, recorded on the recording medium, for translating the transformed security information in the canonical format to a native format of the second security domain; wherein means, recorded on the recording medium, for transforming the security information includes means, recorded on the recording medium, for structure transformation; wherein means, recorded on the recording medium, for translating the security information in a native format of a first security domain to a canonical format comprises a procedural software function;

wherein means, recorded on the recording medium, for translating the transformed security information in the canonical format to a native format of the second security domain comprises a procedural software function; and expressing the canonical format in XML, whereby security information is translated between the first native format and the second native format via the canonical format via XSL. One would be motivated to do so to disburse the integration over the several participants of the communication, thereby reducing the complexity of the conversion (Bussler, 2:30-36)

13. Finally, although neither Dunn nor Bussler expressly disclose the second native format is expressed in XML, it is notoriously well known for a federation native format to be expressed in XML. For example, SAML is an XML-based standard for exchanging authentication and authorization data within a federation. Official notice of this teaching is taken. It would be obvious to one of ordinary skill in the art at the time the invention was made for the second native format to be expressed in XML. One would be motivated to do so because SAML is a proven standard for exchanging authentication and authorization data within a federation. The aforementioned cover the limitations of claims 19-28.

14. As per claims 1-9, the rejections of claims 19-28 under 35 USC 103(a) as being unpatentable over Dunn in view of Bussler are incorporated herein. In addition, although neither Dunn nor Bussler expressly disclose the first native format is expressed in XML, it is notoriously well known for a federation native format to be expressed in XML. For example, SAML is an XML-based standard for exchanging authentication and authorization data within a federation. Official notice of this teaching

is taken. It would be obvious to one of ordinary skill in the art at the time the invention was made for the first native format to be expressed in XML. One would be motivated to do so because SAML is a proven standard for exchanging authentication and authorization data within a federation. The aforementioned cover the limitations of claims 1-9.

15. As per claims 10-18, they are claims corresponding to claims 19-28, and they do not teach or define above the information claimed in claims 19-28. Therefore, claims 10-18 are rejected as being unpatentable over Dunn in view of Bussler for the same reasons set forth in the rejections of claims 19-28.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See enclosed PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is 571-272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

/Jung Kim/
Primary Examiner, AU 2432